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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/637,082	08/11/2000	Scott A. Williams	0175-0284P	8126

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 04/22/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/637,082

Applicant(s)

WILLIAMS ET AL.

Examiner

Victor S Chang

Art Unit

1771

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 03 April 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
2. ☐ The proposed amendment(s) will not be entered because:  
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ they raise the issue of new matter (see Note below);  
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_  
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached NOTE.  
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-45 and 58-62.

Claim(s) withdrawn from consideration: 46-57.

8. ☒ The proposed drawing correction filed on 4/9/2003 is a) ☒ approved or b) ☐ disapproved by the Examiner.  
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_  
10. ☐ Other: \_\_\_\_\_

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1300-  
1700

*Daniel Zinker*

**NOTE**

1. Applicants' argument that the finality of the outstanding Office action is improper, because "the Examiner has agreed that his previous rejections were legally insufficient" and "the finality of the outstanding Office action denies Applicants the opportunity to response to the rejection on the merits" (Response, page 2, first complete paragraph), is not persuasive. It should be noted that in response to Applicants' request (Response dated 8/20/02, page 7, third paragraph) the Examiner merely provided reasoning as regards his desire to specify the order of the layers, which does not result in a new issue and thus the finality of the Office action is proper. Further, it should also be noted that Applicants do have opportunity to amend the claims in After Final Response so as to overcome the 35 USC 112 second paragraph rejection, Applicants remarks to the contrary notwithstanding.

2. With respect to the missing element, i.e., anti-static layer (26), the Examiner notes that the amended draft of Fig. 1 has been accepted.

3. Applicants' traversal that the introduction of the language "alternatively" or "or alternatively" does not change the scope of the Specification (Response, pages 3-4 bridging paragraph) is not persuasive. The Examiner notes that the original Specification discloses a peeling method of peeling layers 23, 24, and 25 away from the support layer 21 prior to heat transferring these layers to a substrate. Specifically the original peeling method includes steps of applying heat only to the side of support which does not carry imaging layer. It must be noted that the amended Specification,

Art Unit: 1771

however, broadens the scope to include an alternative peeling method of applying heat to the other side of support as well, i.e., the side which carries the imaging layer.

Regarding the passages provided by Applicants at page 4, lines 3-19; page 6, lines 17-26; and page 52, lines 3-13 in the Specification as support for the amendment, the Examiner notes that page 4, lines 3-19, provides a method for transferring peeled layers (23, 24 and 25) to substrate, not the peeling method as set forth above. As to page 6, lines 17-26, the Specification appears to be explaining the advantage of not having the Adhesion Layer as an outer layer, so as to keep the imaging device clean, i.e., again, it is irrelevant to the peeling method as set forth above, and also Applicants' remark that "the high temperature at which the present polymer layers melt make them suitable for laser printers and copiers" appears to be inconsistent with the teaching of the Specification. Lastly, the process described at page 52, lines 3-13, again, is for transferring peeled layers (23, 24 and 25) to a substrate, not peeling method as set forth above. As such, the Examiner reiterates that Applicants are required to cancel new matter (see section 7 of Paper No. 11).

4. With respect to Applicants arguments relating to the "order of the layers" and "composition" (Response, pages 5-6, bridging paragraph), Applicants' traversal appears persuasive, and the Examiner withdraws the 35 USC 112, second paragraph, rejection. Lastly, the Examiner repeats that the recitation of "at least" <sup>before</sup> ~~is~~ Markush claim <sup>language</sup> ~~is~~ appears improper and redundant.

5. With respect to Applicants argument that "no motivation exists to combine these two references" and "Meyers '739 specifically discloses that removing the support is

Art Unit: 1771

inconsistent with the invention of Meyers '739" (Response, page 9), the Examiner notes that both Meyers and Kronzer are from the same field of endeavor, i.e., heat transfer label. As such, it would have been obvious to one of ordinary skill in the art to combine the teachings of Meyers and Kronzer, motivated by the desire to provide a removable protective support layer to Meyer's heat-sealable label. Further, it is believed that one of ordinary skill in the art would readily recognize that Meyer's "support" layer is not the same as the removable "support" layer of the instant claimed invention, i.e., instead Meyer's "support" layer is functionally equivalent to the "optional opaque layer" of the instant claimed invention, Applicants remarks to the contrary notwithstanding. It should also be noted that the fact that Meyers discloses additional structure not claimed is irrelevant.

6. With respect to Applicants argument that "Meyers '739 never intends to remove the support from the article" and "the limitations of "pressure sensitive adhesive layer" and "adhesion layer".... are neither suggested nor disclosed with Meyers '739" (Response, page 10, first complete paragraph), the Examiner notes that Meyers has not explicitly exclude the use of a protective layer; also Applicants argue the cited references individually. It should be noted that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references.